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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91177234
Party	Defendant Alaris Group, Inc., The
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Attachments	2008 05 05 Alaris Group Response to Motion to Strike.pdf (8 pages)(285350 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

1. CARDINAL HEALTH 303, INC. Opposer v. THE ALARIS GROUP, INC. Applicant	Opposition No. 91-177,234
2. CARDINAL HEALTH 303, INC. Opposer v. THE ALARIS GROUP, INC. Applicant	Opposition No. 91-177,365
3. CARDINAL HEALTH 303, INC. Opposer v. THE ALARIS GROUP, INC. Applicant	Opposition No. 91-177,366
4. CARDINAL HEALTH 303, INC. Opposer v. THE ALARIS GROUP, INC. Applicant	Opposition No. 91-177,367

5. CARDINAL HEALTH 303, INC.	:	
Petitioner	:	
v.	:	Cancellation No. 92-048,172
THE ALARIS GROUP, INC.	:	
Registrant	:	

THE ALARIS GROUP'S RESPONSE TO THE CARDINAL HEALTH MOTION TO STRIKE THE OSLICK DECLARATION AND PORTIONS OF THE REPLY BRIEF THAT REFERENCE THE OSLICK DECLARATION

Cardinal Health's Motion to Strike The Oslick Declaration is baseless, because the Oslick Declaration meets the requirements in Trademark Board Manual of Procedure Section 528.05(b) and under the applicable Federal Rules of Evidence.[1] The CH Motion to Strike, moreover, is overly broad in that CH has only asserted that ¶ ¶ 4, 5 and 6 of the Oslick Declaration fail to meet the requirements in TBMP § 528.05(b), but the Motion seeks to strike broader portions of the Reply Brief.

In any event, the outcome of Cardinal Health's Motion to Strike is of no consequence. Even without the allegedly deficient paragraphs of the Oslick Declaration, it is obvious that summary judgment should be granted because the doctrines of laches and estoppel bar Cardinal Health's claims against The Alaris Group, Inc. The Oslick Declaration paragraphs in question summarized certain points based on the documents Cardinal Health produced in discovery, which is not an issue central to the grounds upon which summary judgment should be granted in this case.

[1] The Federal Rules of Evidence are applicable here. *See* TBMP §101.02 (providing that the Federal Rules of Evidence apply in Board proceedings).

TBMP Section 528.05(b) Requirements Are Met

"Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (1) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein." TBMP § 528.05(b); *see also* Fed. R. Civ. P. 56(e). Testimony about what is shown in a document production is commonly given by the lawyer or paralegal which actually looked at the subject document production. *See, e.g., Okland Oil Co. v. Knight*, 92 Fed.Appx. 589, 606 (10th Cir. 2003) (discussing an affidavit from plaintiffs counsel Brian Petersen which described the contents of a document production); *Nilavar v. Mercy Health Sys.*, No. 3:99cv612, 2004 U.S. Dist. LEXIS 30531, at *3 (S.D. Ohio Mar. 22, 2004) (discussing affidavits describing the contents of a document production).

"In certain circumstances, it is appropriate for attorneys to submit personal affidavits in support of their motions for summary judgment. Counsel may present admissible evidence in an affidavit where the evidence relates to items in the case, such as items in the record or items produced in discovery." *N. Trade U.S., Inc., v. Guinness Bass Import Co.*, No. 3:03cv1892, 2006 U.S. Dist. LEXIS 54435, at *5 (D. Conn. Aug. 7, 2006) (citing 11 Moore's Federal Practice § 56.14(1)(c) (Matthew Bender 3d ed. 2006).

Mr. Oslick personally reviewed every document produced and provides his Declaration with his description of what he reviewed. *See* Oslick Declaration ¶ 3. As both an attorney for The Alaris Group and as a former trademark examiner, Mr. Oslick's background certainly makes him competent to review discovery produced in this matter and to accurately describe what it does and does NOT contain.

Notably, CH has not asserted that the statements made by Mr. Oslick are inaccurate. Mr. Oslick's statements are summaries based on his legal review of the discovery produced by CH and clarify what the documents do NOT include.[2] If the statements were wrong, CH could have presumably produced a discovery document or a competing affidavit to counter the Declaration statement. The Oslick Declaration did exactly what such affidavits are intended to do-it summarized what was NOT found in the discovery produced. Attaching the entire 2700+ page discovery production for the TTAB to review would have imposed much too large a burden on the Board.

There is no reason that the Oslick statements would not be admissible in evidence. What more than 2700 documents produced in discovery show or fail to show is *not* a matter reserved for specialized or expert opinion, as the question is *not* a matter only understood with the assistance of an expert qualified with scientific, technical or other specialized knowledge. *See* Fed. R. Evid. 702. Instead, the question of what more than 2700 documents produced in discovery show or fail to show is a matter properly subject of non-expert opinion testimony under Fed. R. Evid. 701. Fed. R. Evid. 701.

FRE 704 Specifically Allows For The Oslick Testimony Even If It Embraces An Ultimate Issue

Even if Mr. Oslick's description of the Cardinal Health document production can be characterized as opinion testimony that embraces an ultimate issue, it is still allowable and admissible. Fed. R. Evid. 704 provides that "testimony in the form of an opinion or inference otherwise admissible is not objectionable because it embraces an ultimate issue to be decided by the trier of fact." Fed. R. Evid. 704.

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[2] CH argues that Mr. Oslick "attaches not a single produced document…" which is ironic since Mr. Oslick's statements are based on what the discovery does NOT show. Also, Mr. Oslick's Declaration does attach produced responses to discovery documents as Attachment A.

FRCP 56(e) Specifically Allows For The Oslick Testimony If It Would Be Admissible As Testimony

"If admissible facts and inadmissible statements are mingled in the same affidavit, the court may rely on the facts and disregard the rest. Affidavits submitted by attorneys for the parties are tested under these standards." *Cohen v. Ayers*, 449 F. Supp. 298, 321 (N.D. Ill. 1978) (internal citation omitted). "An affidavit may only be disregarded if it contains conclusions of law or of ultimate fact, statements made upon information and belief, or argument. *Id.*[3]

Finally, attorneys are expected to present matters in a cohesive manner to assist the court, as the Western District of New York succinctly observed:

> In her affidavits, [plaintiff's attorney] is not testifying as to facts at issue in this case. Her affidavits are vehicles placing before the court relevant, admissible documents and the relevant portions of sworn testimony of witnesses with personal knowledge. Given the complexity of this case, and the numerous documents and many pages of testimony that have been generated during the discovery process, [plaintiff's attorney's] affidavits present the evidence in a cohesive manner. *See Moore's Federal Practice* § 56.14[1][c], p. 56-160. The documents attached to the [plaintiff's attorney's] affidavits were created as part of the litigation (e.g., discovery materials), with which [plaintiff's attorney] is familiar. In addition, the court agrees with [plaintiff] that the case law pillar of the summary judgment standard, *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548, 91 L.Ed.2d 265 (1986), allows a degree of attorney characterization in its instruction that a party explain the basis for its motion and identify the relevant evidence supporting its evidence. *Id.* at 323, 106 S. Ct. 2548.

New York v. Solvent Chem. Co., 218 F. Supp. 2d 319, 331 (W.D.N.Y. 2002).

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[3] "It is the policy of rule 56(e) to allow the affidavit to contain evidentiary matter, which if the affiant were in court and testified on the witness stand, would be admissible as part of his testimony." *Am. Sec. Co. v. Hamilton Glass Co.*, 254 F.2d 889, 893, 117 U.S.P.Q. (BNA) 219 (7th Cir. 1958) (internal citation omitted). The fact that the declarant has not supported his allegations is not in and of itself a sufficient cause for disregarding his sworn statement. *4U Co. of Am., Inc. v. Naas Foods, Inc.*, 175 U.S.P.Q. (BNA) 251, 253 (T.T.A. B. 1972) (internal citations omitted). "Statements of this character have previously been received in evidence under the "clear" and "convincing" doctrine expressed by the Court of Customs and Patent Appeals. Suspicion alone is insufficient to invalidate the operative facts set out in a supporting affidavit." *Id.*

Here, Mr. Oslick's statements do not state a conclusion of law and were not offered as proof of an ultimate fact, but rather as an admissible inference from what CH's produced discovery failed to show.

Only ¶ ¶ 5 and 6 of Mr. Oslick's Declaration are challenged as inadmissible,[4] but CH moved to strike the entire Oslick Declaration, notwithstanding the narrow claim of inadmissibility. CH attempts the same overbroad elimination of a portion of the Reply to the Summary Judgment Motion by referencing the Oslick Declaration paragraphs alleged to be deficient as applying to the "paragraph beginning at the bottom of page three and continuing to page four."[5] In point of fact, only two sentences of this referenced paragraph are cited by ¶ ¶ 5 and 6 of the Oslick Declaration. The second sentence is also, however, supported by CH's own admission in its response to Interrogatory # 7 which was attached to the Oslick Declaration. CH's argument to strike the second sentence therefore should also be denied as inappropriate based on the additional evidentiary basis which is uncontested.

Conclusion

There is no reason to strike the Oslick Declaration or the related sentence of the Reply to the Summary Judgment Motion. The Oslick Declaration was based on personal

[4] Although CH argues that ¶ 4 of the Oslick Declaration is inadmissible as evidence, this paragraph is not referenced in the Reply to the Summary Judgment Motion so the argument is moot.
[5] CH Response to the Summary Judgment Motion at n 1.

knowledge. He is competent to testify the matter stated therein, and his statements are admissible in evidence.

Respectfully submitted,

Dated: May 5, 2008

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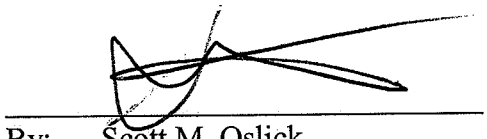
CERTIFICATE OF FILING

I hereby certify that THE ALARIS GROUP'S RESPONSE TO THE CARDINAL HEALTH MOTION TO STRIKE is being filed electronically through on-line TTAB filing systems, ESTTA on May 5, 2008.



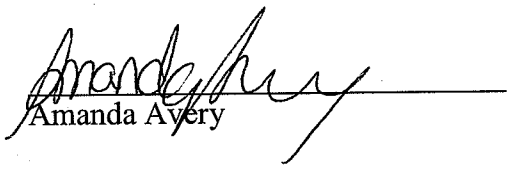
By: Scott M. Oslick

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing THE ALARIS GROUP'S RESPONSE TO THE CARDINAL HEALTH MOTION TO STRIKE has been served on counsel for Applicant by first class mail, postage prepaid, this 5th of May, 2008 as follows:

Mary True
Bricker & Eckler LLP
100 S. Third Street
Columbus, OH 43215-4291

Date: 5/5/08



Amanda Avery